REMARKS

Applicant has carefully considered the Final Action. Applicant offers the above amendments and following remarks in a sincere attempt to place this application in condition for allowance. Applicant has amended Claim 102 in this response.

Applicant thanks the Examiner for indicating the allowance of Claim 18.

Claims 70-101 stand rejected under 35 U.S.C. §101 ("Section 101") as allegedly directed towards non-statutory subject matter. Specifically, the Examiner asserts that the claims "are drawn to a 'computer program product embodied on a tangible computer readable medium'" and that "[t]he specification is silent regarding the meaning of the term 'tangible computer readable medium.'" Final Action, Page 2.

Applicant respectfully disagrees and notes that in Claim 70, Applicant specifically claims "[a] computer program product embodied on a <u>tangible</u> computer readable medium" (emphasis added), which is clearly statutory. Additionally, Applicant respectfully directs the Examiner's attention to Paragraph [0035] of Applicant's Specification, which discloses that "[m]ain memory 230 may include a <u>random access memory</u> (RAM) or another type of <u>dynamic storage device</u> that <u>stores information and instructions for execution by processor</u> 220" and that "ROM 240 may include a conventional <u>ROM device</u> or another type of <u>static storage device</u> that stores static information and <u>instructions for use by processor</u> 220" (emphasis added), which are clearly examples of tangible computer readable mediums. Therefore, Applicant's claimed "tangible computer readable medium" is clearly supported by the Specification, as claimed. Of course, such citations (in combination with the remaining specification) are merely examples of the above claim language and should not be construed as limiting in any manner.

Accordingly, Applicant respectfully requests the Examiner withdraw the Section 101 rejections of Claims 70-101.

Claims 102-133 also stand rejected under Section 101 as allegedly directed towards non-statutory subject matter. Applicant respectfully asserts that such rejection is avoided in view of the amendment made hereinabove to independent Claim 102. Specifically, amended Claim 102 recites, in relevant part, "a processor." Accordingly, Applicant respectfully requests the Examiner withdraw the Section 101 rejections of Claims 102-133.

Claims 22, 91, and 123 stand rejected under 35 U.S.C. §112, first paragraph, ("Section 112") as allegedly failing to comply with the written description requirement. Specifically, the Examiner asserts that "the original disclosure did not support matching hash values of legitimate mailing lists based on the body of the e-mail message." Final Action, Page 3.

Applicant respectfully disagrees. As an example, Applicant directs the Examiner to Paragraph [0067] of Applicant's Specification, which discloses "hashing of the message text" (emphasis added). Applicant also directs the Examiner to Paragraphs [0080]-[0081] of Applicant's Specification, which state that "[i]f the message text is substantially replicated (e.g., greater than 90%), hash processor 410 may check one or more portions of the e-mail message against known legitimate mailing lists within hash memory 420 (act 522) (FIG. 5C)" and that "[i]f there is a match with a legitimate mailing list (act 524), then the message is probably a legitimate mailing list duplicate and may be passed with no further examination" (emphasis added).

Therefore, Applicant's claimed "comparing the generated hash values to known legitimate mailing lists; and passing the plurality of e-mail messages without further examination when the generated hash values match one or more of the known legitimate mailing lists" is clearly supported by the Specification, as claimed. Of course, such citations (in combination with the remaining specification) are set forth by way of example only and should not be construed as limiting to the claims in any manner.

Accordingly, Applicant respectfully requests the Examiner withdraw the Section 112 rejections of Claims 21, 91, and 123.

Claims 1-3, 5, 11-15, 17, 22-26, 28, 67-72, 74, 80-84, 86, 91-95, 97, 99-104, 106, 107, 112-116, 118, 123-127, 129, and 131-133 stand rejected under 35 U.S.C. §103(a) ("Section 103") as allegedly unpatentable over Pace et al. (U.S. Patent No. 6,460,050)("Pace"), and further in view of Bandini et al. (U.S. Patent Publication No. 2002/0199095)("Bandini"), and further in view of Starbuck et al. (U.S. Patent Publication No. 2004/0221062)("Starbuck"). Applicant respectfully disagrees with these rejections.

With respect to the independent claims, the Examiner relies on Paragraphs [0023], [0025], and [0038] from Bandini to make a prior art showing of Applicant's claimed "counting a number of the generated hash values corresponding to the message body associated with one of the plurality of e-mail messages that match the hash values corresponding to the message body associated with prior e-mail messages" (see this or similar, but not necessarily identical language in the independent claims).

Applicant respectfully asserts that the excerpts from the Bandini reference relied upon by the Examiner teach that "[t]he intercepted message attribute data relevant to the first evaluation in the comparison is extracted (step 64)," "[t]he attribute data is examined in accordance with the evaluation (step 66)," and that "[t]he evaluation result is added to a running comparison score according to the relative weight of the evaluation (step 68)." Bandini, Para. [0023] (emphasis added). Further, the excerpts teach that "[i]nformation that is derived by processing of the known SPAM messages is also stored in the database 37" and that "[i]n one embodiment, a hash computation result based on the message body, or portions of the message body, is stored in the database 37." Bandini, Para. [0025] (emphasis added).

However, merely disclosing that "[t]he evaluation result is added to a running comparison score according to the relative weight of the evaluation" and that "a hash computation result based on the message body, or portions of the message body, is stored

in the database" (emphasis added), as in Bandini, fails to teach Applicant's claimed "counting a number of the generated hash values corresponding to the message body associated with one of the plurality of e-mail messages that match the hash values corresponding to the message body associated with prior e-mail messages" (emphasis added). Clearly, **adding** the evaluation result to a running comparison score and deriving a hash computation result based on the message body, or portions of the message body, as in Bandini, simply fails to teach or suggest Applicant's claimed "**counting a number of** the generated hash values corresponding to the message body associated with one of the plurality of e-mail messages that match the hash values corresponding to the message body associated with prior e-mail messages" (emphasis added).

In addition, Applicant notes that Paragraph [0038] from Bandini, as relied upon by the Examiner, discloses that "borderline messages are processed by an administrator" and that "[t]he administrator is preferably provided with a form, similar to that provided to a recipient, to indicate whether the borderline message is SPAM" (emphasis added). Further, the excerpt discloses that "[w]hen a message is identified as SPAM (step 93), the SPAM database 37 is updated with message data (step 90)." Bandini, Para. [0038] (emphasis added).

However, disclosing that "borderline messages are processed by an administrator" who "indicate[s] whether the borderline message is SPAM" and that "the SPAM database 37 is updated with message data," as in Bandini, simply fails to teach or suggest Applicant's claimed "**counting a number of** the generated hash values corresponding to the message body associated with one of the plurality of e-mail messages that match the hash values corresponding to the message body associated with prior e-mail messages" (emphasis added).

Nevertheless, the Examiner argues in the Final Action that Bandini teaches Applicant's specific claim language in "Fig. 3, step 66 compare various message attributes to data in database (i.e., previous hash values)." Applicant respectfully disagrees and asserts that step 66 of Bandini's Figure 3 teaches "Compare Attribute Data

to Data in Datasheet." Further, Bandini teaches that "[t]he attribute data is examined in accordance with the evaluation (step 66)" and that "[t]he evaluation result is added to a running comparison score according to the relative weight of the evaluation (step 68)" (emphasis added).

However, "Compar[ing] Attribute Data to Data in Datasheet" and "add[ing the evaluation result] to a running comparison **score**" (emphasis added), as in Bandini, simply fails to teach or suggest Applicant's claimed "determining a first suspicion **count** based on **a number of** the hash values associated with the prior e-mail messages that match the one or more first hash values, and determining a second suspicion **count** based on **a number of** the hash values associated with the prior e-mail messages that match the second hash value" (emphasis added). Clearly, adding the evaluation result to a running comparison **score**, as in Bandini, fails to teach Applicant's claimed "suspicion **count** based on a number of the hash values associated with the prior e-mail messages" (emphasis added), as claimed by Applicant in the context of the entire claim.

With respect to Claim 68, the Examiner relies on Paragraphs [0009] and [0025] from Starbuck as allegedly showing Applicant's claimed technique "wherein the processing the e-mail messages by removing the HTML comments and the HTML tags from the e-mail messages occurs in parallel with the generating the hash values."

Applicant respectfully asserts that the Starbuck excerpts relied upon by the Examiner merely disclose "a pre-processing technique for detecting and removing obfuscating clutter from the subject and/or body of a message" and that "[t]he technique utilizes the powerful features built into an HTML rendering engine to strip the HTML instructions for all non-substantive aspects of the message." Starbuck, Para. [0009] (emphasis added). Further the excerpts disclose that "FIG. 2… illustrate[s] a flow chart of the pre-processing algorithm for the present invention" and that "it is to be understood and appreciated that the present invention is not limited by the order of acts, as some acts may, in accordance with the present invention, occur in different orders and/or concurrently with other acts from that shown and described herein." Starbuck, Para.

[0025] (emphasis added). Applicant notes that Figure 2 discloses the steps of "Receive Message [200]," Perform MIME Decoding [202]," "Pre-Render Message to Final Format [204]," and "Convert to Text-Only Version [206]." Starbuck, Fig. 2.

However, merely disclosing "strip[ping] the HTML instruction for all non-substantive aspects of the message" and that the steps of "Receive Message," "Perform MIME Decoding," "Pre-Render Message to Final Format," and "Convert to Text-Only Version" may occur in different orders and/or concurrently, as in Starbuck, fails to teach Applicant's claimed technique "wherein the processing the e-mail messages by removing the HTML comments and the HTML tags from the e-mail messages occurs in parallel with the generating the hash values" (emphasis added). Clearly, performing MIME decoding, pre-rendering message to final format, and converting to text-only version, as in Starbuck, fails to teach "generating the hash values" as claimed, and in particular "wherein the processing the e-mail messages by removing the HTML comments and the HTML tags from the e-mail messages **occurs in parallel** with the generating the hash values" (emphasis added), as claimed by Applicant in the context of the entire claim.

Claims 16 et al. stand rejected under Section 103 as allegedly unpatentable over Pace, in view of Bandini, in view of Starbuck, and further in view of Bates (U.S. Patent No. 6,985,923)("Bates"). Specifically, the Examiner relies on Col. 1, lines 22-30 (excerpted below) from the Bates reference as allegedly showing Applicant's claimed "determining that the one of the plurality of e-mail messages is a potentially unwanted email message when the first suspicion count is higher than the second suspicion count." Specifically, the Examiner argues that "Bates teaches determining that a message is unwanted when the same message is received from different senders." However, Bates teaches:

> One problem associated with the utilization of forwarded messages is that
> a particular user or recipient may repeatedly receive the same e-mail
> message from different senders. The recipient may eventually become
> cluttered with redundant e-mail messages or become annoyed with reading
> or receiving these redundant e-mail messages.

Therefore, <u>a need exists for a method, article of manufacture and apparatus for processing redundant e-mail messages</u>."

Bates, Col. 1, lines 22-30 (emphasis added).

In the Final Action, the Examiner argues that "Applicant's specification discloses that if a main text count is significantly higher than the from/to suspicion count, the message is more suspicious (¶ [0074])" and that "[i]n view of Applicant's disclosure, Bates reasonably teaches to one of skill in the art that identical messages received from multiple different sources are likely to be unwanted."

Applicant again respectfully asserts that the excerpt from the Bates reference relied upon by the Examiner merely teaches that "[t]he <u>recipient</u> may eventually become cluttered with redundant e-mail messages or become <u>annoyed with reading or receiving these redundant e-mail messages</u>" and that "a <u>need</u> exists for a method, article of manufacture and apparatus for <u>processing redundant e-mail messages</u>" (emphasis added). However, merely disclosing that "[t]he recipient may eventually... become <u>annoyed</u> with reading or receiving these redundant e-mail messages" and that "a need exists... for <u>processing redundant e-mail messages</u>," as in Bates, simply fails to teach or suggest Applicant's claimed "determining that the one of the plurality of e-mail messages is a potentially unwanted email message when the <u>first suspicion</u> **count** is <u>higher</u> than the <u>second suspicion</u> **count**" (emphasis added). Clearly, disclosing a <u>need</u> for processing redundant e-mail messages, as in Bates, fails to teach or suggest a "suspicion <u>count</u>" as claimed, and in particular Applicant's claimed "determining that the one of the plurality of e-mail messages is a potentially unwanted email message **when** the first suspicion count is higher than the second suspicion count" (emphasis added), as claimed by Applicant in the context of the entire claim.

Claims 20 et al. stand rejected under Section 103 as allegedly unpatentable over Pace, in view of Bandini, in view of Starbuck, and further in view of Schiavone et al. (U.S. Patent Publication No. 2002/0120705)("Schiavone"). Specifically, the Examiner relies on Figure 3 and Paragraph [0023] from Bandini as allegedly showing Applicant's

claimed "generating a suspicion score for the plurality of e-mail messages based on a result of the counting of the number of the generated hash values corresponding to the message body associated with the one of the plurality of e-mail messages that match the hash values corresponding to the message body associated with the prior e-mail messages."

Applicant respectfully asserts that the Bandini Figure and excerpt relied upon by the Examiner merely disclose that "[t]he intercepted message attribute data relevant to the first evaluation in the comparison is extracted (step 64)," "[t]he attribute data is examined in accordance with the evaluation (step 66)," and that "[t]he evaluation result is added to a running comparison score according to the relative weight of the evaluation (step 68)" Bandini, Para. [0023] (emphasis added).

However, merely disclosing that "[t]he intercepted message attribute data relevant to the first evaluation in the comparison is extracted…, examined" and that "[t]he evaluation result is added to a running comparison score" (emphasis added), as in Bandini, simply fails to teach or suggest Applicant's claimed "generating a suspicion score for the plurality of e-mail messages based on a result of the **counting of** the number of the generated hash values corresponding to the message body associated with the one of the plurality of e-mail messages that match the hash values corresponding to the message body associated with the prior e-mail messages" (emphasis added).

Again, since at least the third element of the *prima facie* case of obviousness has not been met, Applicant respectfully requests a notice of allowance, or a specific prior art showing of each of the foregoing claim elements, in combination with the remaining claimed features.

Thus, Applicant respectfully submits that all of the independent claims are deemed allowable. Moreover, the remaining dependent claims are further deemed allowable, in view of their dependence on allowable independent claims.

As such, Applicant respectfully submits that Claims 1-29 and 67-133 now stand in condition for allowance in full. Applicant therefore respectfully requests full allowance of Claims 1-29 and 67-133.

Applicant requests an extension of time to respond and encloses herewith the appropriate fee. Applicant does not believe that any other fees are due. However, in the event that any fees are due, the Director is hereby authorized to charge any required fees due (other than issue fees), and to credit any overpayment made, in connection with the filing of this paper to Deposit Account No. 50-4964 of Stragent, LLC (Order No. SVIPGP085).

Should the Examiner deem that any further amendment is desirable to place this application in condition for allowance, Applicant invites the Examiner to telephone the undersigned attorney at the number listed below.

Respectfully submitted,

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